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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,325	01/03/2002	Harry W. Eberle III	(HWE-107A)	5841

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EXAMINER	
GARCIA, ERNESTO	
ART UNIT	**PAPER NUMBER**
3679	

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/037,325	EBERLE, HARRY W.	
	Examiner	Art Unit	
	Ernesto Garcia	3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 October 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *29-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *29-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 September 2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Drawings

The drawings filed on September 12, 2003 are objected to because the hatching for the anchoring device 51, in Fig 7, is incorrect for plastic material. See MPEP § 608.02. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 29, 31 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Great Britain patent, GB-1,350,754 (see marked-up attachment).

Regarding claim 29, the British patent discloses, in Figure 10, an anchoring device consisting essentially of a substantially flat horizontal top element **A10**, at least one substantially vertical support member **A20**, and a substantially flat horizontal bottom element **A30**. The top element **A10** has a top view configuration including two sides **A2** and a predetermined first width **A3** as measured side to side. The first width **A3** is measured at a maximum width between the sides **A2**. The top element **A10** has an imaginary center line **A4**. The support member **A20** is attached to an underside **A6** of the top element **A10** along the center line **A4** and the support member **A20** extends downwardly therefrom. The support member **A20** has two sides **A7** and a predetermined second width **A8** as measured side to side at a maximum width. The bottom element **A30** has a flat bottom view configuration, which includes sides A31, and having a generally trapezoidal shape, and a predetermined third width **A11** as measured side to side at a maximum width at a trapezoidal base **B1**. The first width **A3** is greater than the second width **A8** and the third width **A11**. The third width **A11** is greater than the second width **A8**. The device is made of molded plastic material (column 4, lines 72-84).

Applicant is reminded that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not

constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Therefore, the anchoring device can be adapted to maintain the top element in a predetermined position during use for joinder of two adjacent boards pre-cut with receiving slots, and to position the bottom element upon a support board, which the two boards rest for attachment of the anchoring device to the support board for anchoring and support the two boards.

Furthermore, for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising". See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355. See MPEP 2111.03.

Regarding claim 31, the two sides **A2** of the top element **A10** are symmetric relative to one another.

Regarding claim 32, the two sides **A2** of the top element **A10** are parallel to one another.

Claims 33 and 35-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Chen et al., 6,363,677 (see marked-up attachment).

Regarding claim 33, Chen discloses in Figure 5, a decking system comprising boards **A20** and an anchoring device **A26**. Each of the boards **A20** has a top **A21**, a bottom **A22**, two sides **A23** and two ends **A24**. At least one groove **A25** is located along one of the sides **A23**. The anchoring device **A26** consists essentially of a substantially flat horizontal top element **A1**, at least one substantially vertical support member **A5**, and a substantially flat horizontal bottom element **A9**. The top element **A1** has a top view configuration including two sides **A2** and a predetermined first width **A3** as measured side to side. The first width **A3** is measured at a maximum width between the sides **A2**. The top element **A1** has an imaginary center line **A4**. The support member **A5** is attached to an underside **A6** of the top element **A1** along the center line **A4** and the support member **A5** extends downwardly therefrom. The support member **A5** has two sides **A7** and a predetermined second width **A8** as measured side to side at a maximum width. The bottom element **A9** has a flat bottom view configuration, which includes sides A10, and having a generally trapezoidal shape, and a predetermined third width **A11** as measured side to side at a maximum width at a trapezoidal base **B1**. The first width **A3** is greater than the second width **A8** and the third width **A11**. The third width **A11** is greater than the second width **A8**. The device is made of molded plastic material capable of having a metal fastener driven through (col. 7, lines 56-60).

Applicant is reminded that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Therefore, the anchoring device can be adapted to maintain the top element in a predetermined position during use for joinder of two adjacent boards having been pre-cut with receiving slots, and to position the bottom element upon a support board, which the two boards rest for attachment of the anchoring device to the support board for anchoring and support the two boards.

Furthermore, for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising". See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355. See MPEP 2111.03.

Regarding claim 35, the two sides **A2** of the top element **A1** are symmetric to one another.

Regarding claim 36, the groove **A25** establishes an upper half **A30** of each of the boards **A20** above the groove **A25** and a lower half **A31** of each of the boards **A20** below the groove **A25**. The upper half **A30** has a greater width than the lower half **A31**. Compare widths **A32** and **A33**.

Regarding claim 37, the boards **A20** are made of material selected from the group consisting of synthetic polymers, at least partially foamed synthetic polymers, wood, wood composite, and combinations thereof (col. 4, lines 22-50).

Regarding claim 38, the two sides **A2** of the top element **A1** are parallel to one another.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al., 5,704,181.(see marked-up attachment).

Regarding claim 29, Fisher et al. disclose, in Figure 3, an anchoring device comprising a substantially flat horizontal top element **14b**, at least one substantially vertical support member **14c**, and a substantially flat horizontal bottom element **14a**. The top element **14b** has a top view configuration including two sides **A2** and a predetermined first width **A3** as measured side to side. The first width **A3** is measured

at a maximum width between the sides **A2**. The top element **14b** has an imaginary center line **A4**. The support member **14c** is attached to an underside **A6** of the top element **14b** along the center line **A4** and the support member **14c** extends downwardly therefrom. The support member **14c** has two sides **A7** and a predetermined second width **A8** as measured side to side at a maximum width. The bottom element **14a** has a flat bottom view configuration which includes sides **A10** and having a generally trapezoidal shape, and a predetermined third width **A11** as measured side to side at a maximum width at a trapezoidal base **B1**. The first width **A3** is greater than the second width **A8** and the third width **A11**. The third width **A11** is greater than the second width **A8**.

However, Fisher et al. fail to disclose the device made of molded plastic material. Applicant is reminded that, within the general skill of a worker in the art, selecting a known material on the basis of its suitability for the intended use is a matter of obvious design choice. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the device of plastic. *In re Leshin*, 125 USPQ 416. Furthermore, it is well known that plastic material is capable of having a metal fastener driven through.

Applicant is reminded that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Therefore, the anchoring device can be adapted to maintain the top element in a predetermined position during use for joinder of two adjacent boards pre-cut with receiving slots, and to position the bottom element upon a support board, which the two boards rest for attachment of the anchoring device to the support board for anchoring and support the two boards.

Furthermore, for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355. See MPEP 2111.03.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al., 5,704,181, as applied to claim 29 above, and further in view of Naccarato, 6,442,908.

Regarding claim 30, Fisher et al., as modified above, fail disclose the vertical support member **14c** having recesses with support columns located therebetween. Naccarato et al. teach, in Figs. 4 and 5, a vertical support member **14c** having recesses **15** to promote optimal flow of grout material through the support member (col. 5, lines 29-35). Therefore, as taught by Naccarato et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to include recesses in the

vertical support member to promote optimal flow of grout material through the support member. Applicant is reminded that columns will be inherently located between the recesses as shown in Figure 3 of Naccarato et al.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Major, 556,998 (see marked-up attachment), in view of Fisher et al., 5,704,181.

Regarding claim 33, Major, discloses, in Figure 1, a decking system comprising boards **B** and an anchoring device **A**. Each of the boards **B** has a top **e**, a bottom **c**, two sides **I2** and two ends (Fig. 2A). At least one groove **I** is located along one of the sides **I2**. The anchoring device **A** consists essentially of a substantially flat horizontal top element **k**, at least one substantially vertical support member **A5**, and a substantially flat horizontal bottom element **A9**. The top element **k** has a top view configuration including two sides **A2** and a predetermined first width **A3** as measured side to side. The first width **A3** is measured at a maximum width between the sides **A2**. The top element **k** has an imaginary center line **A4**. The support member **A5** is attached to an underside **A6** of the top element **k** along the center line **A4** and the support member **A5** extends downwardly therefrom. The support member **A5** has two sides **A7** and a predetermined second width **A8** as measured side to side at a maximum width. The bottom element **A9** has a flat bottom view configuration, which includes sides **A10**, and a predetermined third width **A11** as measured side to side at a maximum width at a

base. The first width **A3** is greater than the second width **A8** and the third width **A11**. The third width **A11** is greater than the second width **A8**.

However, Major, fails to disclose, the bottom element **A9** having a generally trapezoidal shape, and making the anchoring device **A** of molded plastic material.

Fisher et al. teach, in Figure 3, a bottom element **14a** of an anchoring device consisting essentially of a trapezoidal shape to have a dissymmetric anchoring device so that it increase load-bearing capacity (col. 4, lines 17-36). Therefore, as taught by Fisher et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the bottom element having a generally trapezoidal shape so that the anchoring device has a dissymmetric shape to increase load-bearing capacity. Note, the base will be a trapezoidal base due to the horizontal bottom element having a trapezoidal shape.

In regards to the material, applicant is reminded that, within the general skill of a worker in the art, selecting a known material on the basis of its suitability for the intended use is a matter of obvious design choice. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the device of plastic. *In re Leshin*, 125 USPQ 416. Furthermore, it is well known that plastic material is capable of having a metal fastener driven through.

Furthermore, for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising". See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355. See MPEP 2111.03.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Major, 556,998, in view of Fisher et al., 5,704,181, as applied to claim 33 above, and further in view of Naccarato, 6,442,908.

Regarding claim 34, Major, as modified above, fails disclose the vertical support member having recesses with support columns located therebetween. Naccarato et al. teach, in Figs. 4 and 5, a vertical support member **14c** having recesses **15** to promote optimal flow of grout material through the support member (col. 5, lines 29-35). Therefore, as taught by Naccarato et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to include recesses in the vertical support member to promote optimal flow of grout material through the support member. Applicant is reminded that columns will be inherently located between the recesses as shown in Figure 3 of Naccarato et al.

Response to Arguments

Applicant's arguments with respect to claims 21-28 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The new limitation "consists essentially of" in lines 1-2 of new claim 29, and in line 5 of new claim 33 necessitated the new grounds of rejection.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 9:30-6:00. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

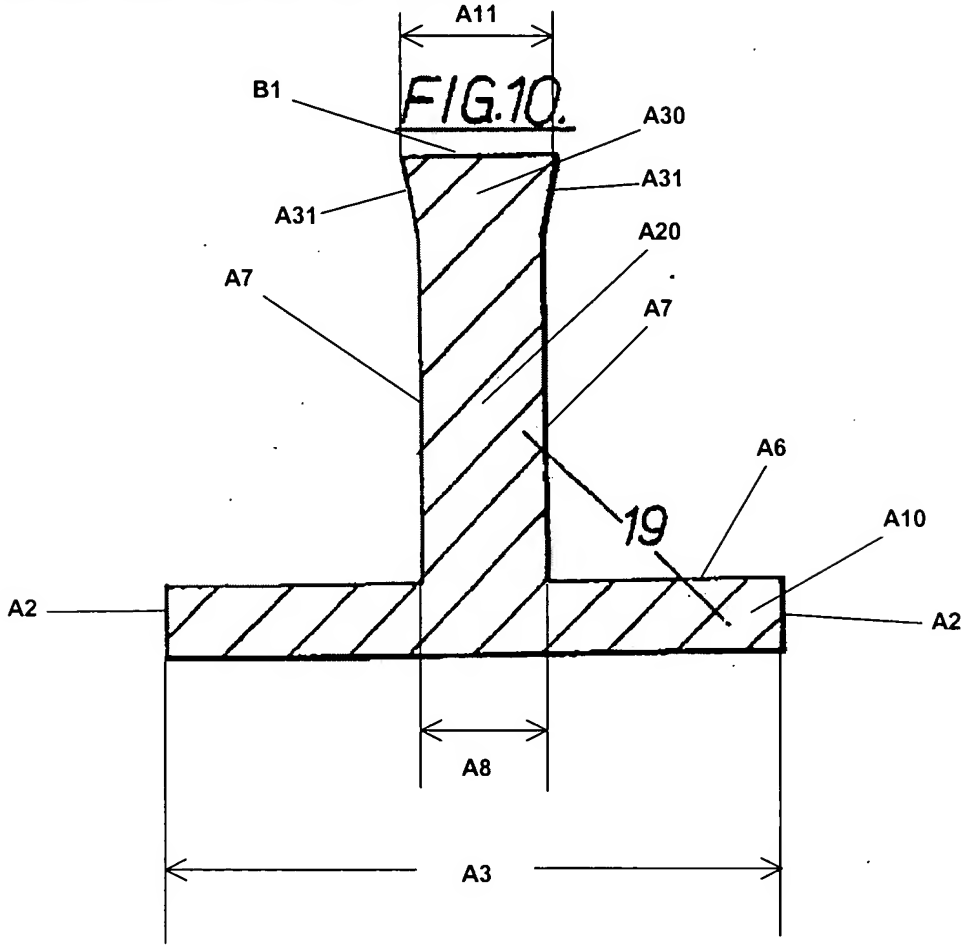
E.G.

December 23, 2004

DANIEL P. STODOLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Attachments: one marked-up page of British patent, GB-1,350,754;
one marked-up page of Chen et al., 6,363,677;
one marked-up page of Major, 556,998; and,
one marked-up page of Fisher et al., 5,704,181;

(Great Britain patent) GB-1,350,754



6,363,677 (Chen et al.)

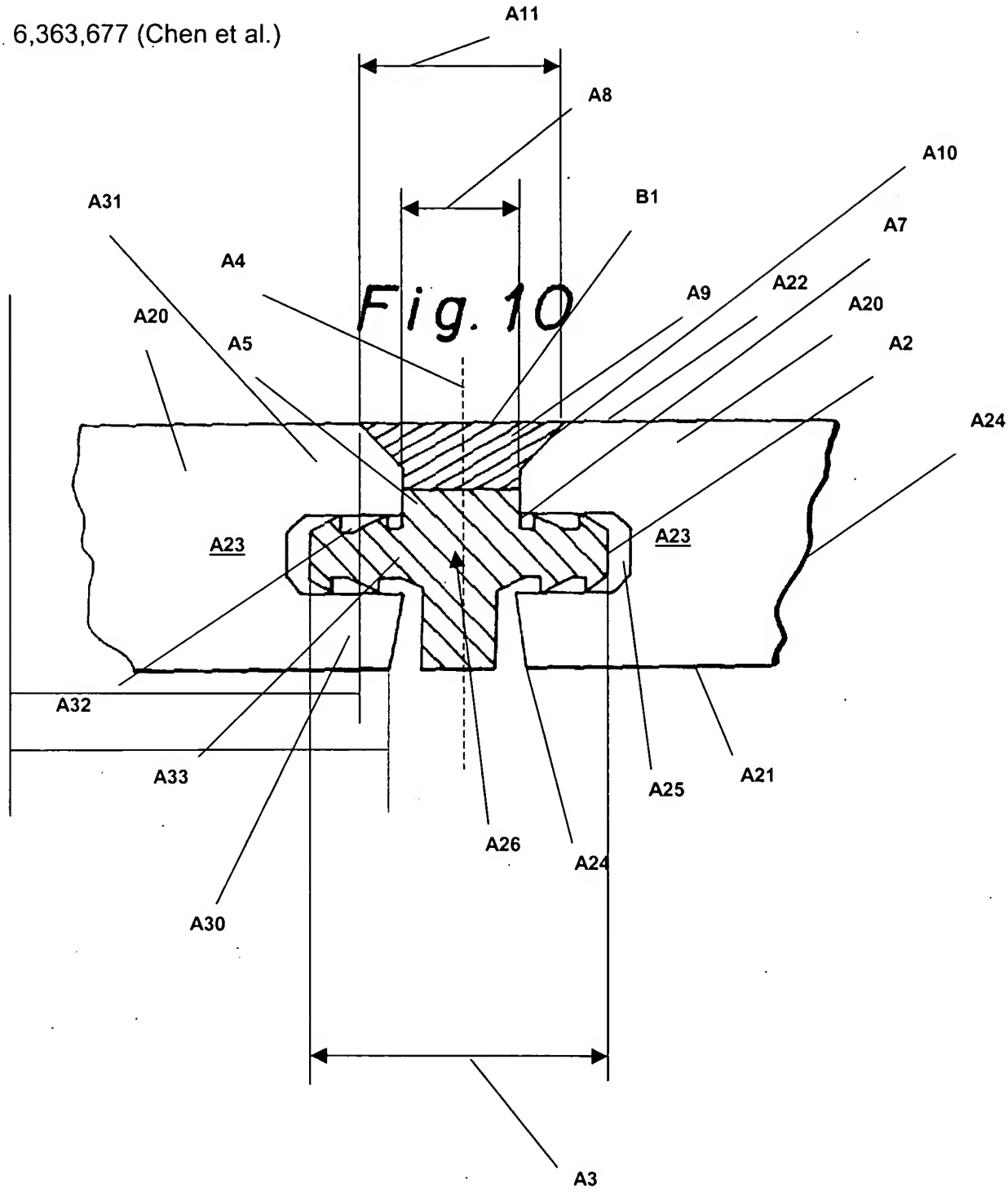


Fig. 10

556,998 (Major)

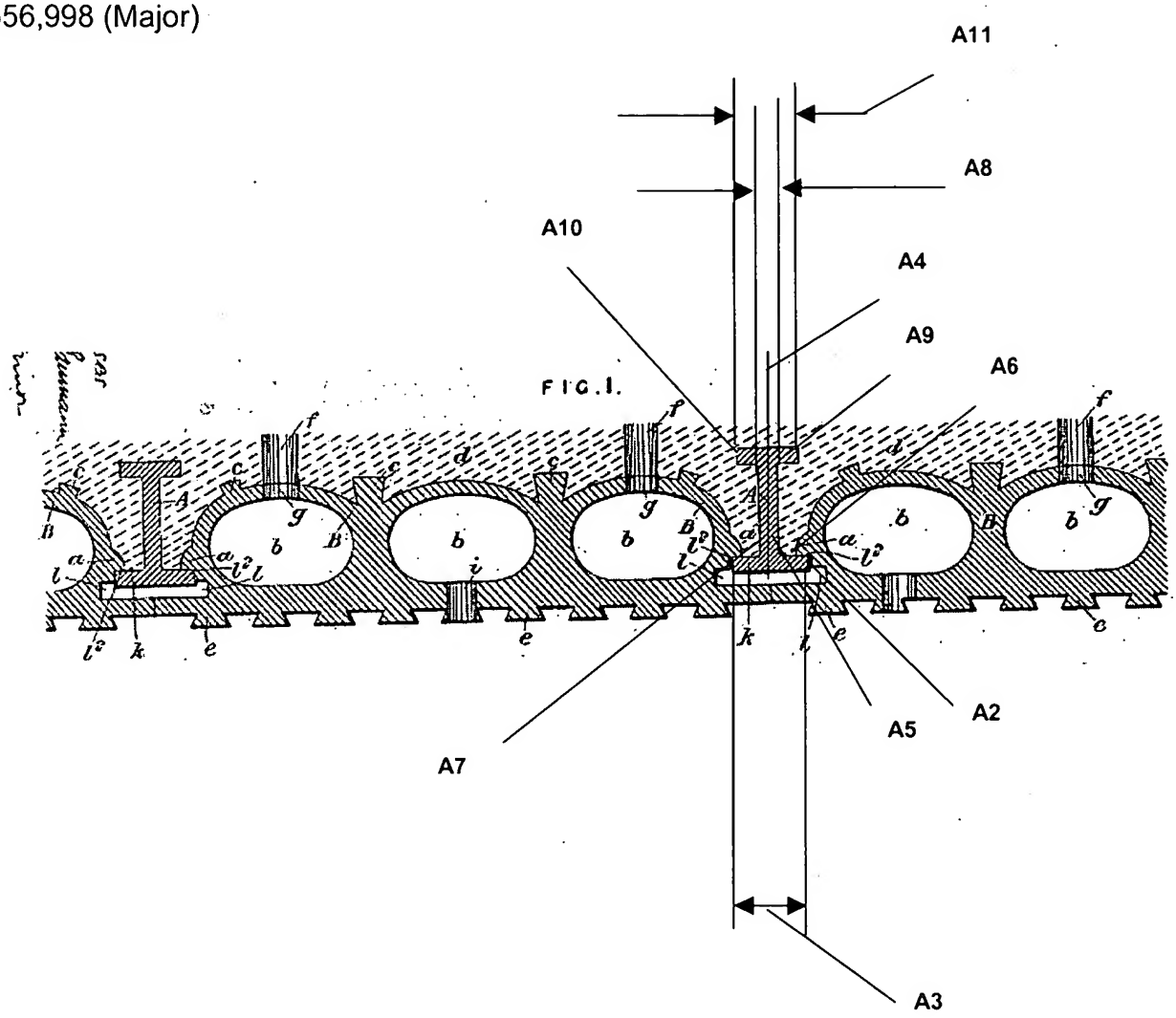


FIG. 1.

5,704,181 (Fisher et al.)